

REMARKS/ARGUMENTS

The Final Office Action of October 6, 2004 has been fully considered by the Applicants. In view of the following discussion, Applicants submit that claims 1-24 are in condition for allowance. Applicants respectfully request entry of the Amendments and that the Examiner withdraw the rejections and allow claims 1-24.

A. Status of the Claims

Claims 1-5, 8, 9, and 11-15 stand rejected. Claims 1-2, 7, and 11-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,801,337 to Higgins. Claims 6, 10, and 25-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 25-27 are cancelled herein.

The Examiner allowed claims 16-24.

B. Claims 1-2, 7, and 11-15 Are Patentable Over Higgins

The Examiner rejected claims 1-2, 7, and 11-15 under 35 U.S.C. §103(a) as being unpatentable over the '337 patent to Higgins. The Examiner states that the rejection is maintained for the same reasons disclosed in the previous Office Action. Applicants respectfully traverse this rejection.

Claims 1-2, 7, and 11-15 are not obvious in view of Higgins. Higgins does not teach or suggest a nitrate to chromium plus cobalt ratio of less than 1.5:1. Applicants have previously shown that the examples of Higgins show a mole ratio of 2.1:1, which is outside the claimed ratio of less than 1.5:1.

Applicants respectfully submit that the Examiner's arguments actually further supports the Applicant's position. In response to the Applicant's arguments, the Examiner argues that if the amount of cobalt implemented in the example (of Higgins) was closer to the higher limit of Higgins's disclosed range, i.e., closer to 3 grams per liter, then the total amount of chromium plus cobalt would produce a ratio of nitrate to chromium plus cobalt that is less than the claimed ratio of 1.5:1. Applicants point out that the claimed ratio is for a mole ratio. Higgins, however, only discloses the concentration of its components in terms of grams per liter. The mole concentration of nitrate is based on the stoichiometric relationship of the nitrate to the metal. Thus, as the divalent cobalt is increased, the nitrate would be accordingly increased in the

appropriate stoichiometric ratio, which is 2 moles of nitrate per mole of divalent cobalt. Consequently, at the high limit of the disclosed range of Higgins, the nitrate to chromium plus cobalt mole ratio is 1.74, which is outside the claimed range of 1.5:1. The ratio gets larger as the chromium is decreased. Further, the mole ratio of 1.74 does not even take into account any nitrate that may be present from the addition of iron as iron nitrate, as indicated in the Examples of Higgins, or if the chromium is added as a nitrate, each of which would cause the ratio of Higgins to climb even further. Thus, there is simply no indication in the Higgins reference to indicate that the mole ratio of nitrate to chromium plus cobalt overlaps the ratio of nitrate to chromium plus cobalt of 1.5:1 recited in the instant claims.

Applicants further submit that there is no teaching or suggestion in Higgins to motivate one skilled in the art to modify Higgins to arrive at the claimed invention. First, Higgins does not teach any specific nitrate ranges. The Examiner has not shown where a person skilled in the art would be motivated to modify the ranges of the Higgins reference to arrive at a composition having a mole ratio of nitrate to chromium plus cobalt of less than 1.5:1. "The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01. Applicants submit that the Examiner has not shown where the Higgins reference suggests the desirability of modifying its teachings to arrive at the present claims. For at least these reasons, Applicants submit that Higgins does not render the present claims obvious.

In order to expedite prosecution, however, claims 1, 8, 11, and 12 are amended herein to recite that the coating composition for conversion coating bath composition are acidic. The Examiner indicated in the Office Action that such claims would be allowable. Applicants respectfully submit that the amendments put the claims in better condition for allowance and therefore respectfully request entry of the amendments by the Examiner. In view of the foregoing, Applicants submit that claims 1-2, 7, and 11-15 and any claims dependent therefrom are patentable over Higgins. Applicants respectfully request that the rejection be withdrawn.

Applicants note that the Examiner withdrew the rejection of claims 3-6 and 8-10. Applicants further note that the Examiner did not include claims 3-6 and 8-10 in any of the current rejections. The Examiner, however, did not explicitly include claims 3-6 and 8-10 in the list of allowable subject matter. Applicants respectfully request clarification of the status of claims 3-6 and 8-10 in view of the withdrawal of the previous rejection of

those claims. Applicants respectfully submit that claims 3-6 and 8-10 are in condition for allowance.


CONCLUSION

In view of the foregoing, Applicants respectfully request that the Examiner enter the amendments to claims 1, 8, 11, and 12. Applicants submit that, along with claims 16-24, claims 1-15 are in condition for allowance. Applicants respectfully request that a Notice of Allowance be issued.

Respectfully submitted,

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December 9, 2004
Date



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